

REMARKS

In response to the Office Action dated May 23, 2003 claims 1, 8, 9, 11, 13, 14, 15 and 16 are amended. Claims 1-16 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1, 4, 8, 9 and 11-15 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is respectfully traversed as to claims 1, 4 and 11-14.

The written description requirement is different from the enablement requirement of the first paragraph of 35 U.S.C. § 112. See *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977). The function of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application here relied on, of the specific subject matter later claimed by him. See *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (CCPA 1978). The question is not merely one of literal support for the questioned claim language in the original disclosure, it is one of the disclosure of concepts. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984) and *In re Kaslow*, 707 F.2d 1366, 2177 USPQ 1089 (Fed. Cir. 1983).

The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the present application, as

originally filed reasonably conveys to the artisan that the inventor had possession, at the time of filing of the application, of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Note, for example, *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

It should be noted also that the disclosure need not recite the claim language in *haec verba*. *In re Smith*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973).

With this in mind, the present written description clearly conveys to a person of ordinary skill in the art that the “control unit” of claim 1 would be the CPU 41 of the copying machine (the apparatus), as this CPU is described as controlling, *inter alia*, the copy control at step S45 of Fig. 5 (see also page 11, line 22 to page 13, line 1, and page 22, lines 4-9). With regard to the analyzing unit of claim 1, the present written description clearly conveys to a person of ordinary skill in the art that this would be CPU 11 of DT 1, as described at page 20, line 5 to page 21, line 4 (see also page 9, lines 19-20 describing the control program stored in ROM 14).

With regarding to the “management unit” of claim 4, the present written description clearly conveys to a person of ordinary skill in the art that this would be CPU 91 of the computer of the center, and the control unit would be CPU 11 of DT 1, which is connected between CPU 91 and the copying machine 4 (the apparatus), and which performs the remote command processing S800/S900 of Fig. 11 (see Figs. 12 and 13).

With regard to means, the Examiner asserts beginning at the bottom of page 1 under (v), “no means are recited in the disclosure, therefore none of the claimed apparatus means are supported by the disclosure”. However, the sixth paragraph of 35 U.S.C. § 112 permits *an element in a claim* for a combination to be expressed as a means or step for performing a

specified function without recital of structure, material, or acts in support thereof, and such claim shall be construed *to cover the corresponding structure, material, or acts described in the specification and equivalents thereof*. See *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). The specification need not use the word “means”, as apparently implied by the Examiner.

In claim 8 (as well as other claims), the “counting means” is changed to “clock means” and would correspond to clock IC 17 of Fig. 2, the “analyzing means” would correspond to CPU 11 of DT 1 performing steps S531 and S533, and the “expiration date and time managing means” would correspond to CPU 11 of DT 1 performing steps S800/S900 of Fig. 11, as further shown in Figs. 12 and 13.

In claim 11, the “threshold value storing means” would correspond to non-volatile memory 16, as described at page 23, lines 3-7.

In claim 14, the expiration date and time setting means of the centralized management unit corresponds to the CPU 91 sending out this information, as described on page 21, lines 17-19; the “first communicating means” corresponds to Serial I/Fs 12 and 42; the “second communicating means” corresponds to Network Interface Card (NIC) 18; the “analyzing means” analyzing means” would correspond to CPU 11 of DT 1 performing steps S531 and S533, “threshold means” would correspond to non-volatile memory 16, as described at page 23, lines 3-7, and “expiration date and time managing means” would correspond to CPU 11 of DT 1 performing steps S800/S900 of Fig. 11, as further shown in Figs. 12 and 13

Thus, the means plus function recitations are fully disclosed in the written description and the recited means cover the disclosed corresponding structure, material and

acts. Furthermore, as demonstrated above, the present written description evinces that all the claimed concepts are sufficiently disclosed so as to enable one skilled in the relevant art to make and use the invention, as well as demonstrating to such one skilled in the relevant art that Applicants (the inventors), at the time the application was filed, had possession of the claimed invention. Consequently, withdrawal of the rejection of claims 1, 4 and 11-14 is respectfully solicited.

As to claim 15, this claim is amended to change "counting means" to "expiration date and time setting means for setting expiration date and time information of the apparatus management data", which is consistent with what is provided the centralized management unit. In addition, as noted above, claims 8, 9, 11, 13 and 14 are amended to change "counting means" to "clock means for providing a current time".

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

I. Claims 2-5, 7-9 and 11-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. (USPN 5,184,179; hereinafter Tarr) in view of Jarvis (USPN 5,918,010). However, the rejection is improper as claims 2 and 3 since these claims depend from independent claim 1, which requires the addition of Jarvis (USPN 5,918,010), as set in item number 7 on page 4 of the Official Action. } ①

The rejections are respectfully traversed.

The Examiner admits that Tarr does not teach permitting transmission based on a transmission date and time information included in the (transmitted) data packet and a expiration information held deciding a period for which the apparatus management data is valid for transmission. The Examiner contends that Jarvis teaches a system/method related

to transmission of a data packet between managed processor, the transmission of data in a packet, permitting transmission based on expiration (transmission) date and time information included in the packet and a threshold in the packet and a threshold value information deciding a period for which the apparatus management data is valued for transmission, including permitting transmission of data which has not expired, including obtaining time information from a clock, current time included in a packet. Finally, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art to combine Jarvis with the teaching of Tarr to meet the terms of the claims.

However, the present rejection is a example of impermissible use of hindsight considerations to combine the references to reject the claims, as what is disclosed in Jarvis relates to information (data packets) handled within a single system (each respective linecard 12, 14) having first and second processors and not to an arrangement, such as disclosed in Tarr, where management data is transferred between monitoring systems (for copiers) and a billing computer 50 via a communications network such as a telephone line. Jarvis recognizes that packets are received by and transmitted from networks (13, 15), but does not recognize that data received by the respective interface 30 from a respective network 13, 15 may also be too old (stale). More specifically, as described at column 2, lines 37-58:

In each of the linecards, the interface unit 30 and packet processing unit 32 each operate within their own separate time domain, and there is no communication therebetween, other than by the transfer of data packets. Each unit 30,32 includes an absolute time clock or timer 31,33 so that timing information may be included within packets of data therebetween. In the particular protocol used, data packets received over the network must not be allowed to exist in the system after a certain time period to ensure that stale data is not transmitted around the system. To facilitate this, data packets received by the interface unit 30 are "time-stamped" with an expiry time, which is generated from the absolute time

clock therein. These packets are passed to the packet processor where they will be buffered until the packet processor is capable of handling them. Likewise, packets processed for sending over the networks 13,15 by processor 32 are stamped with an expiry time by the packet processor to ensure that the interface unit 30 does not transmit old data packets. Time-stamp information is checked at entry and exit of the processor unit 32 and interface unit 30. Any packet received after its expiry time is deemed to contain stale data and is therefore to be discarded. (Emphasis added)

Thus, Jarvis is only concerned with a packet(s) **NOT** becoming stale between the time the packet is received by an interface of a single system (such as a linecard) from a data communications network (such as an Internet) and the time the packet is actually handled by a packet processor of the linecard, as well as the reverse, which is the time between when a packet is handled by a packet processor of the linecard and the time the packet is actually received by the interface of the linecard for transmission onto the communications network (such as an Internet).

There is no disclosure or suggestion in Jarvis of time-stamping a data packet with the time that the interface of the linecard transmits the data packet onto the communications network (such as an Internet), then time stamping this transmitted data packet when the data packet is received by the addressed unit, and then using this time information for discarding stale data packets received via the communications network (such as an Internet). In fact, there is no recognition by the applied prior art references that delay of a data packet during transmission on the communications network (such as an Internet) can result in such transmitted data packet becoming stale by the time it is received at its ultimate (addressed) destination).

Again, Jarvis is concerned only with preventing, in a single system such as a linecard, a received data packet becoming stale between the time it is received by an

interface of the linecard from the communications network (such as an Internet) and the time it is handled by the packet processor of the linecard, as well as preventing a data packet to be transmitted onto the communications network (such as an Internet) from becoming stale between the time it is handled by the packet processor of the linecard and the time it is actually received by interface of the linecard for transmission onto the communications network (such as an Internet); i.e., preventing *contribution to staleness* of the data packet by the linecard itself.

In view of the above, a person of ordinary skill in the art would have no realistic motive to combine the teaching of Jarvis with the arrangement of Tarr to meet the terms of the present claims. More specifically, a person of ordinary skill in the art would not look to the teaching of Jarvis to modify the arrangement of Tarr so that only valid data, which is transmitted between the central management unit 54 and the apparatus management units 40, 10 via the telephone line is used by either of the units. This is what is taught in the present application, not Jarvis. Thus, the only apparent motivation of record for the proposed modification of the system disclosed by Tarr to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

II. Claims 1, 6, 10 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. (USPN 5,184,179; hereinafter Tarr) in view of Jarvis (USPN 5,918,010), and further in view of Frantz (USPN 6,003,070).

The rejections are respectfully traversed. Independent claims 1 and 16 are patentable over Tarr and Jarvis for the reasons stated above in I. As claim 6 depends from claim 4 and claim 10 depends from claim 8, they are patentable over Tarr and Jarvis also, even when considered in view of Frantz.

III. Claim 1 is amended to delineate “a receiving unit for receiving a mail transmitted from a management unit via a communication network” and claim 16 is amended to delineate “receiving a mail transmitted from a management unit via a communication network”.

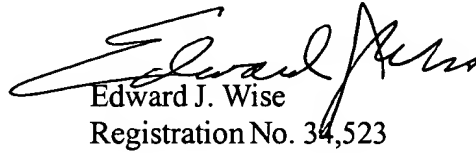
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:khh\cac
Facsimile: (202) 756-8087
Date: August 22, 2003